

REMARKS

I. Summary of Office Action

Claims 1-30 were pending in this case.

In the Office Action, the Examiner contends that the Rule 132 Declaration of Bruce Davis ("the Davis Declaration") submitted by applicants on June 27, 2003 lacks evidence of nonobviousness commensurate with the scope of the pending claims.

As a result, the Examiner maintained the rejection of claims 1-30 under 35 U.S.C. § 103(a) as being obvious from Reiter et al. U.S. Patent No. 4,751,578 ("Reiter") in view of Young U.S. Patent No. 4,706,121 ("Young").

II. Summary of Examiner Interview

Applicants wish to thank the Examiner for the telephonic interview of March 23, 2004, during which the Davis Declaration was discussed. Applicants respectfully disagreed with the Examiner's contention that the Davis Declaration lacks evidence of nonobviousness commensurate with the scope of the pending claims. The Examiner agreed to reconsider the Davis

Declaration in this case upon the filing of a Request for Continued Examination by applicants.

III. Summary of Applicants' Reply

Applicants maintain the position that the Davis Declaration demonstrates the nonobviousness of the pending claims. In particular, as set forth below by applicants, the Davis Declaration contains objective evidence of copying, long-felt need and commercial success of applicants' claimed invention.

Reconsideration and allowance of this application in light of the following remarks is respectfully requested.

IV. The § 103 Rejection of Claims 1-30

The Examiner acknowledges in the Office Action that the Davis Declaration discusses the "Browse" feature disclosed by applicants' specification (Office Action, § 3, page 4, lines 8-9). Indeed, applicants' Browse feature continues to be one of the most highly regarded and most frequently used

interactive program guide (IPG) features.* However, the Examiner contends that the evidence of nonobviousness contained in the Davis Declaration is not commensurate with the scope of "the claimed invention" (Office Action, § 3, page 4, lines 10-15). Applicants respectfully disagree.

Applicants' claimed invention is directed to a method (claim 1), system (claim 11) and interactive media guide (claim 21) for displaying a second program corresponding to a selected interactive program listing, in response to receiving a user selection of the listing from a display on which the listing and video for a current program are simultaneously displayed. For example, applicants' FIG. 12 shows a Browse display on which a current program, for example, "Looking for Miracles" is simultaneously displayed with an interactive program listing for a second program "Educational Programming" (Applicants' specification, page 30, lines 2-19). In response to a user selection of the interactive program listing, video corresponding to the second program "Educational

* Applicants direct the Examiner's attention to the "IPG Attitude and Usage Study" cited by applicants in the Supplemental Information Disclosure Statement filed concurrently with this Reply.

Programming" is displayed (Applicants' specification, page 31, lines 12-18).

Applicants respectfully submit that the Davis Declaration contains objective evidence of the long-felt need, copying and commercial success of applicant's claimed invention. First addressing long-felt need, applicants direct the Examiner's attention to § 11 and Exhibit A of the Davis Declaration, which relate to a 1996 study of EPG usage by 100 cable viewers in Mt. Prospect, Illinois. As declared, the study indicates that:

an average of 40% of the households
used the Browse feature as a primary
method of tuning to other channels
while watching a program

(the Davis Declaration, § 5, lines 7-9; emphasis added). In other words, users highly regarded applicants' claimed approach of displaying a second program corresponding a selected interactive program listing, in response to receiving a user selection of the listing from a display on which the listing and video for a current program are simultaneously displayed. Thus, applicants' claimed invention has filled a long-felt need from both the perspective of the user and the perspective of the service provider. This weighs against a conclusion of

obviousness of applicants' claims (see e.g. *Standard Havens Products, Inc. V. Gencor Industries, Inc.*, 953 F.2d 1360, 1370, 21 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1991)).

Next addressing copying, the Davis Declaration evidences that several commercial IPG providers copied applicants' claimed invention -- i.e., displaying a second program corresponding a selected interactive program listing, in response to receiving a user selection of the listing from a display on which the listing and video for a current program are simultaneously displayed. In particular, the Davis Declaration states that applicants' first publicly disclosed this invention at the Western Cable show in Anaheim, California in December of 1992.* Subsequent to the cable show, the following commercial IPG providers incorporated this invention into their respective EPGs as follows:

* The Davis Declaration references the Rule 131 Declaration submitted by applicants in the parent application of this application in order to show what was demonstrated by applicants at the cable show (see § 2 of the Davis Declaration). For the Examiner's convenience, a copy of the Rule 131 Declaration is enclosed. Applicants direct the Examiner's attention to Exhibit D of the Rule 131 Declaration, and more particularly to the "Carson Screen" and "Lucy Screen" portions of Exhibit D, which indicate that applicants publicly disclosed the claimed invention at the cable show.

Starsight Telecast, Inc. incorporated into its IPG the feature of allowing a user to "tune to [a show indicated in a Browse pop-up] by hitting the remote's tune key" (the Davis Declaration, §§ 4 and 5 and Exhibit C, page 31; emphasis added).

Echostar Communications, Inc. incorporated into its IPG the feature of allowing a user to "[p]ress the Select button to change to the program in the Browse Banner" (the Davis Declaration, §§ 4 and 7 and Exhibit D, page 2-20; emphasis added).

General Instrument incorporated into its IPG the feature of allowing a user to "while watching a current program . . . tune to another program [indicated in a Browse display]" (the Davis Declaration, §§ 4 and 8 and Exhibit E, page 2; emphasis added).

Evidence of copying also weighs against a conclusion of obviousness of applicants' claims (see e.g. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679, 7 U.S.P.Q.2d 1315, 1319 (Fed. Cir. 1988)).

Turning lastly to commercial success, applicants' respectfully submit that the same above-described portions of the Davis Declaration which evidence that applicants' claimed invention was copied by IPG providers, and considered by users to be a highly regarded IPG feature, also evidence the

commercial success of applicants' claimed invention.* The Federal Circuit has consistently held that commercial success, whether of the patentee or infringers, also evidences the non-obviousness of the invention (see e.g. *Akzo N.V. v. U.S. Intl. Trade Commn.*, 808 F.2d 1471, 1481, 1 U.S.P.Q.2d 1241, 1246 (Fed Cir. 1986) ("Commercial success is . . . a strong factor favoring nonobviousness.")).

Accordingly, because the Davis Declaration evidences the nonobviousness of applicants' claimed invention, applicants respectfully submit that the rejections of claims 1-30 under 35 U.S.C. § 103(a) should be withdrawn.

* In the parent application of the this application, applicants also cited § 6 and Exhibit B of the Davis Declaration, which relate to Starsight's licensing of its IPG to consumer electronics companies, as additional evidence demonstrating commercial success. However, as set forth in Exhibit B, commercial success of the Starsight IPG was contingent upon the success of the Starsight subscription-based business model (e.g., Exhibit B, page 1, ¶ 2, page 5, ¶ 1 and page 7, ¶ 1). This business model was not an overall success and, as a result, the Starsight IPG was terminated. Details regarding the termination of the Starsight EPG are set forth in the Supplemental Information Disclosure Statement filed concurrently with this Reply.

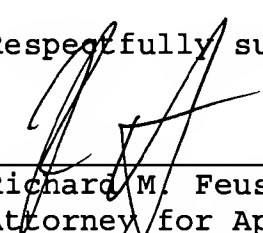
V. Contingent Request for Telephonic Interview

If for any reason the Examiner decides not to allow claims 1-30 of the present application based on this Reply, applicants respectfully request a telephonic interview with the Examiner before the issuance of the next Office Action.

VI. Conclusion

Applicants respectfully submit that this application, including claims 1-30, is in condition for allowance. Prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,



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